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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

NO. .....

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED, Petitioners,

v.

THE BENDIX CORPORATION, Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioners pray that a writ of certiorari issue to review the Judgment of the United States Court of Appeals for the Fourth Circuit entered in the above entitled case on January 17, 1964.

CITATIONS TO THE OPINIONS BELOW

The opinion of the Court of Appeals is reported at 327 F.2d 497 (1964) and appears in the Appendix to this Petition, *infra*, p. 11.

The opinion of the District Court is reported at 218 F. Supp. 1 (1963). A copy of it appears in Volume I, pages 1a-160a, of the Record as printed for the use of

the court below (copies of that Record have been filed here under the provisions of Paragraph 4 of Rule 21). All of those portions of the District Court's opinion which are believed to be pertinent to the questions here presented appear in the Appendix to this Petition, *infra*, pp. 11-2.

JURISDICTION

The Judgment of the Court of Appeals was entered on January 17, 1964. A rehearing was denied March 18, 1964. Jurisdiction of this Court is invoked under 28 U.S.C. Section 1254(1).

QUESTIONS PRESENTED

(1) Is it arbitrary and violative of the due process clause of the Fifth Amendment for a judge, sitting without a jury in a patent case governed by the provisions of the 1952 Patent Act, to decide, subjectively and in the absence of any proof of the fact, that the subject matter of the patent as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains?

(2) Did Congress, in enacting Sections 103 and 282 of the 1952 Patent Act, establish a statutory criterion of invention and presumption of validity which precludes the courts from holding invalid for lack of patentable novelty a patent whose subject matter is not identically disclosed in the prior art, unless there is substantial objective proof that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains?

CONSTITUTIONAL PROVISIONS INVOLVED

Article I, Section 8:

"The Congress shall have Power * * *

"To Promote the Progress of Science and useful Arts, by securing for Limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; * * *." [U.S.C.A., *Constitution*, 1st Vol., p. 39].

Amendment V:

"No person shall * * * be deprived of * * * property, without due process of law; * * *." [U.S.C.A., *Constitution*, Amdts. 1-5 Vol., p. 297].

STATUTES INVOLVED

35 U.S.C. 101: INVENTIONS PATENTABLE: Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. [35 U.S.C.A., 1st Vol., p. 80].

35 U.S.C. 102: CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT: A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, * * *. [35 U.S.C.A., 1st Vol., p. 81].

Statutes Involved.

35 U.S.C. 103: CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER: A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. [35 U.S.C.A., 1st Vol., p. 81].

35 U.S.C. 282: PRESUMPTION OF VALIDITY; DEFENSES: A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. [35 U.S.C.A., 1st Vol., p. 102].

STATEMENT OF THE CASE

This is a civil action charging infringement of three patents (one of them a reissue) claiming certain methods of making "printed circuits" or components thereof. Jurisdiction was invoked under 28 U.S.C. 1338 and was admitted in the Answer. The inventions were made in wartime London by Dr. Paul Eisler, an Austrian refugee. Respondent pleaded the usual defenses of invalidity, non-infringement and misuse by reason of the plaintiffs' licensing practices.

The Complaint was filed May 25, 1959; the trial commenced October 2, 1961, and was concluded on December 6, 1961, and the cause was argued and submitted February 5-7, 1962. More than fifteen months later, on May 27, 1963, the trial judge filed an opinion sustaining all of the defenses and on June 6, 1963, entered judgment of dismissal accordingly. Notice of appeal was filed on the same day.

The trial judge entered no separate findings of fact. In his opinion he primarily held the claims in suit invalid because of "anticipation" (35 U.S.C. 102) by an earlier-filed application of Stevens & Dallas, but added (71a):

> "Should another court find that the alleged Eisler inventions were not identically disclosed or described in the Stevens and Dallas application, this court unhesitatingly finds and holds that 'the differences between the subject matter sought to be patented and the prior art' were 'such that the subject matter as a whole would have been obvious at the time the [alleged] invention[s] [were] made to a person having ordinary skill in the art to which said

subject matter pertains' (35 U.S.C. 103). The court holds that the Stevens and Dallas application — not considered by the Examiner — of itself invalidates the Eisler patents, either as an anticipation, or as showing lack of novelty.

"Even apart from the Stevens and Dallas application the court holds that the other prior art, cited and uncited by the Examiner conclusively shows lack of novelty."

Petitioners appealed. The Court of Appeals evidently agreed with petitioners that there was no anticipation, because it affirmed the trial court on the *sole* ground of "obviousness in the light of the prior art for the reasons fully discussed in the opinion of the District Court".

The "reasons" stated in the opinion of the District Court (collected *infra*, pp. 11-2) are subjective ones; there was no *proof* whatsoever that the subject matter as a whole of any patent in suit "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Stated most favorably for respondent, the *evidence* shows no more than that something *less* than the whole subject matter of any patent was perceived by a few persons of far *more* than ordinary skill in the art, and not at the time the Eisler inventions were made but at a later date or dates.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

(1) The Questions Presented are fundamental ones in patent law which have not been but should be decided by this Court:

The Constitutional standard is that patents shall be granted only for inventions. A patent which falls short of the Constitutional standard should be held invalid but public faith demands that a patent which does meet the standard should be upheld; the constitutional purpose, which is "to promote the progress of science and useful arts", is just as much defeated by the courts when they hold a good patent invalid as when they hold a bad patent valid; *Grant et al. v. Raymond,* 6 Peters 218, 241-2 (1832).

It was settled by this Court in the year 1850 that mere novelty is not enough to sustain a patent; that there must be a difference representing more "ingenuity and skill" than that possessed by "an ordinary mechanic acquainted with the business"; *Hotchkiss v. Greenwood,* 52 U.S. 615 (1850). As far as we are aware, neither this Court nor any other Court of the United States has formulated any minimum requirements for *proof* of invention (or lack of it) in a century of decisions following *Hotchkiss v. Greenwood.* Nor did Congress undertake to formulate an authoritative standard. The result was that decisions came to be "based upon the idiosyncrasies of a merely personal judgment"; cf. *Leland v. Oregon,* 343 U.S. 790, 799 (1952); sometimes resulting in deep divisions within the courts themselves; see, e.g., *Jungersen v. Ostby & Barton Co.,* 335 U.S. 560 (1949).

Reasons for Allowance of Writ.

In the year 1949 Congress undertook a complete study of the patent laws, resulting in the enactment, in 1952, of the present Patent Act (35 U.S.C.A., 1st Vol., p. 6). Two of its provisions are important here:

(i) Section 282 made it statutory that a patent shall be presumed valid by the courts and that the burden of establishing invalidity shall rest on a party asserting it. This presumption and the burden it entails are entirely fair and comport with due process; *Leland v. Oregon, supra;* because they have a rational connection with the ultimate fact to be proven, in that the 1952 Act, like its predecessors, provides elaborate machinery for insuring that no patent shall issue until after it has been rigorously examined in the Patent Office by technically skilled examiners; 35 U.S.C. §§ 111-135.

(ii) Section 103 provided the first statutory yardstick for measuring the inventive quality of an improvement in the useful arts. The Committee Report describes this as one of the two "major changes or innovations" in our patent law, says that the section is added to the statute "for uniformity and definiteness" and says that it "should have a stabilizing effect and minimize great departures which have appeared in some cases" (35 U.S.C.A., 1st Vol., pp. 20, 21); cf. *Aro Mfg. Co. v. Convertible Top Co.*, —— U.S. ——, Law Week, June 9, 1964, 4459, 4463-4.

In opinions written since the 1952 enactment, various of the Courts of Appeals have considered the question whether "invention" is an issue of fact or of law, the most recent case being *Monroe Auto Equipment Co. v. Heckethorn Mfg. Co.*, (C.A. 6, decided May 14, 1964) 141 USPQ 549, not yet officially reported. That case holds, consistent with the concurring opinion of Mr. Justice Black in *Graver Mfg. Co. v. Linde Co.*, 336 U.S. 271,

280-1 (1949) that the *ultimate* question of patentability cannot properly be classified as a finding of fact, but is a question of law.

The *Monroe* decision emphasizes, however, that there must be *a factual basis* for the decision of the ultimate question, and holds invalid the patent there involved on a record which included testimony that "it would have been obvious" to borrow the characterizing feature of the claim from another art in which that feature had been used in the same way. In a case decided four days later, however; *Bain v. The M. A. Hanna Company*, 141 USPQ 559, not yet officially reported; the same Court rejected a similar finding by the trial court, saying (p. 562):

> "We have concluded that the Trial Court's finding of lack of invention is not warranted by this record. There is no evidence that the alleged invention described in Claims 1, 2 and 3, from the entire prior art would be obvious to one skilled in the art. The record simply does not contain any factual basis for such finding and conclusion."

In the instant case, as in the *Bain* case, there is simply no factual basis for a finding and conclusion that the claimed invention "from the entire prior art, would be obvious to one skilled in the art" at the time the Eisler inventions were made; *supra*, p. 6.

These decisions in the Sixth Circuit comport with petitioners' contention that by enacting Sections 282 and 103 Congress defined "the limits of accepted notions of justice" in this area; *Leland v. Oregon, supra;* and mandated that a patent may not be held invalid for lack of invention except on the basis of satisfying *proof* that

"the subject as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" and that a finding of invalidity may no longer be "based upon the idiosyncrasies of a merely personal judgment", as was the finding in this case.

(2) A patent is property and its owner is entitled to the protection of the Fifth Amendment; *Cramp & Sons v. Curtis Turbine Co.*, 246 U.S. 28, 39-40 (1918). Petitioners therefore submit that a decision of invalidity which does not observe but to the contrary flouts the *ratio decidendi* mandated by Sec. 103 violates due process.

(3) Since the Court of Appeals decided this case on the *sole* ground of lack of patentable novelty under Section 103, the questions posed by the petition are squarely presented. Although the 1952 Patent Act is now twelve years old, this Court has never decided any case arising under Sections 282 and 103. The last decision by the Court on the question of "invention" is *A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, decided December 4, 1950. The hope of Congress, that "great departures which have appeared in some cases" would be minimized by the enactment of Section 103, bid fair to remain unrealized until this Court speaks.

Respectfully submitted,

JOHN W. AVIRETT, 2d.
WALTER J. BLENKO
WALTER J. BLENKO, JR.

June 12, 1964

APPENDIX

Opinion of the Court of Appeals

(Caption Omitted)

Filed January 17, 1964

PER CURIAM:

After careful consideration of the record, the arguments and the briefs of counsel, we are persuaded that the patent claims are invalid for obviousness in the light of the prior art for the reasons fully discussed in the opinion of the District Court. Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp., D.C. Md., 218 F. Supp. 1.

Affirmed.

Portions of Opinion of the District Court

(Caption Omitted)

Filed May 27, 1963

[The opinion of the District Court appears in full in Petitioners' appendix in the Court of Appeals, Volume I, pages 1a-160a]

* * * * * * *

The Prior Art.

The most significant single reference in the prior art, from the viewpoint of the court, and apparently from that of the parties to this suit[110] is Application Serial No. 184,419, of Stevens and Dallas, filed January 11, 1938,[111] (not cited of record in the prosecution of any of the patents in suit) and incorporated by reference in Stevens and Dallas Patent No. 2,219,497[112] issued on October 29, 1940. It is urged by defendant both as

anticipation (35 U.S.C. 102) and as evidence of non-invention (35 U.S.C. 103). [p. 57a Appendix]

* * * * * * *

Should another court find that the alleged Eisler inventions were not identically disclosed or described in the Stevens and Dallas application, this court unhesitatingly finds and holds that "the differences between the subject matter sought to be patented and the prior art" were "such that the subject matter as a whole would have been obvious at the time the [alleged] invention[s] [were] made to a person having ordinary skill in the art to which said subject matter pertains" (35 U.S.C. 103). The court holds that the Stevens and Dallas application—not considered by the Examiner—of itself invalidates the Eisler patents, either as an anticipation, or as showing lack of novelty. [p. 71a Appendix]

* * * * * * *

* * * from the prior art the court was then convinced[19] that the mere production of copper lines, which by their very nature were necessarily electrically conductive, by printing and etching did not disclose patentable novelty over the prior art. [p. 97a Appendix]

* * * * * * *

Judgment of the Court of Appeals

(Caption Omitted)

Filed January 17, 1964

THIS CAUSE came on to be heard on the record from the United States District Court for the District of Maryland, and was argued by counsel.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court appealed from, in this cause, be, and the same is hereby, affirmed with costs.